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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/092,379

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Jeffrey M. Dils

11136/10 (PTG-0867-US)

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12/03/2002

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EXAMINER

BISHOP, STEVEN C

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,379

Applicant(s)

DILS ET AL.

Examiner

Steven C. Bishop

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10. 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 37 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a measuring device releasably attached to the upper surface of the housing of the portable power tool, and a battery for powering the tool, does not reasonably provide enablement for the measuring device being in electrical communication with the battery. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with this claim. Please note that claim 37 is not recognized as being an original claim in the application as filed, and thus part of the original disclosure, because the amendment that added the claim was not referred to specifically in the declaration. See MPEP 608, 608.04(a), and 608.04(b).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 39, 41, 43, and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 39, line 2, there is no antecedent basis for "the detecting device".

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Claims 41 and 43 are contradictory to claim 36, from which they depend, by virtue of these claims reciting the measuring device being attached to the handle portion, while claim 36 recites the measuring device being attached to the upper surface of the housing.

In claim 44, there is no antecedent basis for "the housing portion". Also, claim 44 appears to duplicate subject matter recited in claim 36, from which it depends.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 27, 30, 31, 33, 35, 36, 39 (insofar as it is definite), 40, 42, 44 (insofar as it is definite), 45, 47, 49-52, and 55 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wolf.

7. Claims 27, 28, 30, 32, 50, 51, and 53 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Japanese reference '208 (Lee).

8. Claims 27, 28, 30, 33, 35, 36, 38, 40, 42, 50, and 51 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Funakubo.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Wolf, Lee, or Funakubo, and Chang.

Wolf, Lee, and Chang do not specify that their portable tool is battery operated. Chang shows that it is well known in the art to make a portable drill battery powered. See Col. 4, lines 1-8. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the tool of Wolf, Lee, or Funakubo battery powered, as shown to be conventional by Chang, in order to provide enhanced portability of the tool.

12. Claims 34 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee and Fowler.

Lee does not show specifically where the power supply attaches to the handle. Fowler shows that it is old and well known in the art to attach the power supply to the end of the handle adjacent the switch in a tool of this configuration. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to place the power supply of Lee in

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the position shown to be conventional by Fowler, resulting in the detecting device of Lee being adjacent the power supply end.

13. Claims 46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf and Lee.

Although not specifically mentioned, the measuring device of Wolf is capable of being detached and used separately, but Wolf does not show the measuring device being attached to the handle of the tool. Lee shows that it is known in the art to provide one or more measuring devices on the handle of a portable power tool. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to place the measuring device of Wolf on the handle of the tool, as suggested by Lee, as an obvious matter of design choice, especially since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

14. Claims 56, 59, 62, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf and either Nelson et al. or Chang.

Wolf does not show a cavity integrally formed on a surface of the power supply end to retain objects placed within the cavity. Nelson et al. show that it is well known in the art to provide a chuck key receiving cavity on a holder that attaches to the power supply end of a drill handle. Likewise, Chang shows that it is known in the art to provide a holder to the battery pack end of a portable tool handle to retain drill or screwdriver bits. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the tool of Wolf with an object holder attached to the handle, as suggested by either Nelson et al. or Chang, in order to maintain chuck keys, drill bit, or similar items convenient for use.

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15. Claims 57, 58, 60, 61, 63, 64, and 66-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf and either Nelson et al. or Chang, as applied to claims 56, 59, 62, and 65 above, and further in view of Balzano.

Balzano show that it is known in the art to provide magnetic material in the cavities of a tool caddy to be attached to a portable drill. See Fig. 6 and Col. 3, lines 65 - 68. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide magnetic material for the accessory holding devices of Wolf and Nelson et al. or Chang, as suggested by Balzano, in order to more firmly retain metallic accessories.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAX responses to Office Actions directly into the Group at (703) 872-9302. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and Group at the top of your cover sheet. Papers submitted via FAX into Group 3720 will be promptly forwarded to the examiner.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven C. Bishop whose telephone number is (703) 308-1731. The examiner can normally be reached Monday through Thursday from 7:30 AM to 5:00 PM, and on alternate Fridays from 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

A handwritten signature in black ink, appearing to read "Steven C. Bishop". The signature is fluid and cursive, with the first name "Steven" and last name "Bishop" clearly distinguishable.

Steven C. Bishop
Primary Examiner
Art Unit 3722

scb
December 2, 2002